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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,457	07/10/2001	Kuriacosc Joseph	2050.001US6	9752
44367	7590	07/06/2007		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH/OPEN TV P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			EXAMINER GARG, YOGESH C	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 07/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/903,457

Applicant(s)

JOSEPH ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 144-255 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 144-255 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Preliminary amendment received on 7/10/2001 is acknowledged and entered. Claims 1-143 are canceled and new claims 246-255 are added. Currently claims 144-255 are pending for examination.

Requests for changes in title received on 11/14/2002 and 1/30/2003 are acknowledged and entered. The applicant has proposed the title, "*Apparatus for transmitting and receiving executable applications as for a multimedia system, and method and system to order an item using a distributed computing system*" on 1/30/2003.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 144-164, 199-217, 246 and 249, drawn to a method and server system facilitating placing an order for an item by using a server system and a client system communicating with each other (see independent claims 144 and 199) , classified in class 705, subclass 26.
 - II. Claims 165-185, 218-236, 247, 250, 252 and 254, drawn to a client system and a method using a client system receiving an order request, automatically determining identity of item, retrieving personal information from a storage device of the user making the request and causing an order to be placed (see independent claims 165, 218, 252, and 254 , classified in class 705, subclass 26.
 - III. Claims 186-198, 248, 253 and 255 drawn to mere data/information communicated to a client system with intended uses (see independent

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claims 186, 253 and 255). The limitations referring to mere data do not fall into any statutory classes, that is a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof as identified under 35 USC 101

- IV. Claims 237-245 and 251, drawn to a server system with the intended use of facilitating placing order comprising a first source to provide first information, second source to provide second information, and a multiplexer to communicate the first and second information (see independent claims 237, classified in class 709, subclass 231.

3. The inventions are independent or distinct, each from the other because:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in subcombination claim 165 the identity of item is determined from the order request while in combination claim 144 the identity of item is determined utilizing the information related to the item communicated by a server system . The subcombination has separate utility such as a client system receiving an order request and identifying the item from the order request.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the server system in invention I does not require a multiplexer to communicate information from different sources. The subcombination has separate utility such as a server requiring a multiplexer to communicate information from different sources.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination

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is separately usable. In the instant case, subcombination IV has separate utility such as requiring a multiplexer to communicate information from different sources. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification/divergent subject matter/requirement of different search, restriction for examination purposes as indicated is proper.

5. Group I contains claims directed to the following patentably distinct species:

Species 1: claims 145-146, 200-201

Species 2: claims 145, 147, 200, 202

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Species 3: claims 145, 148-149, 200, 203-204

Species 4: claims 145, 153-155, 200, 206-208

Species 5: claims 145, 153, 156-157, 200, 206, 209-210

Species 6: claims 145, 158-160, 200, 211-213

Species 7: claim 150

Species 8: claims 151, 246, 205, 249

Species 9: claims 161, 214

Species 10: claims 162-163, 215-216

The species are independent or distinct because Species 1 does not require the limitations of Species 2 recited in claims 147 and 202. Similarly all species are distinct from each other .

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 144, 164 and 199 are generic in Group I.

6. Group II contains claims directed to the following patentably distinct species:

Species 1: claims 166-167, 219-220

Species 2: claims 166, 168, 219, 221

Species 3: claims 166, 169-170, 173, 219, 222-223

Species 4: claims 171-172, 247

Species 5: claims 166, 174-176, 219, 225-227

Species 6: claims 166, 174, 177-178, 219, 225, 228-229

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Species 7: claims 166, 179-181, 219, 230-232

Species 8: claims 182, 233

Species 9: claims 183-184, 234-235

The species are independent or distinct because Species 1 does not require the limitations of Species 2 recited in claims 168 and 221. Similarly all species are distinct from each other .

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 165, 185, 218, 236, 252 and 254 are generic in Group II.

7. Group IV contains claims directed to the following patentably distinct species:

Species 1: claim 238, 251

Species 2: claims 239-240

Species 3: claims 241-242

Species 4: claims 243-245

The species are independent or distinct because Species 1 does not require the limitations of Species 2 recited in claims 239-240. Similarly all species are distinct from each other .

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 237 are generic in Group IV.

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8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the


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record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Yogesh C Garg
Primary Examiner
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YCG/6/21/2007